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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,583	03/10/2000	Youji Kawamoto	7217/61041	4985

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EXAMINER

WANG, LIANG-CHE A

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 11/07/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/523,583

Applicant(s)

KAWAMOTO ET AL.

Examiner

Liang-che Alex Wang

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/10/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-12 have been examined.

#### *Paper Submitted*

2. It is hereby acknowledged that the following papers have been received and placed of record in the file:
  - a. **Priority** as received on 03/10/2000.
  - b. **Preliminary Amendment** as received on 03/10/2000.

#### *Drawings*

3. The drawings are objected to because of the following minor informalities.
  - a. Figure 1, elements **11<sub>1</sub>**, **11<sub>2</sub>**, and **11<sub>3</sub>** fail to provide English descriptions. Please insert "**Memory Card**" for these elements.
  - b. Figure 5 element **13C**, "**MC INF**" should be changed to "**Memory Card Interface.**"
  - c. Figure 5, elements **11x(11<sub>1</sub>)** and **13G** fail to provide English descriptions. Please provide English description on the drawing for these elements.
  - d. Figure 9 element **31C**, "**MC INF**" should be changed to "**Memory Card Interface.**"
  - e. Figure 9, please provide English descriptions to elements **11x(11<sub>2</sub>)** and **31F**.
  - f. Figure 10, please provide English descriptions to elements **11x(11<sub>3</sub>)** and **47C**.

Art Unit: 2155

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The disclosure is objected to because of the following informalities:
  - a. Page 6, line 17, the word “**him**” should be changed to “**the user**.”

Appropriate correction is required.

***Claim Objections***

6. Claims 2, 3, 5, 6, 8, 10-12 are objected to because of the following informalities:
  - a. Claims 2, 5, 8, 10, 11 have mentioned about the network server forms “**a group of users,**” but the network server actually forms “**a group of terminal devices used by users.**”
  - b. All dependent claims are objected to as having the same deficiencies as the claims they depend from.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

Art Unit: 2155

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floden et al. US Patent Number 6,230,002 B1, hereinafter Floden, in views of Hyde-Thomson, US Patent Number 5,557,659, hereinafter Thomson.
9. Referring to Claim 1, Floden has taught a network system (Fig. 1, element 10), a terminal device (Fig. 1, element 24) and a network server (Fig. 1, element 16) connected to the said terminal device via prescribed communication means (Figure 1, element 32, there are various ways of communication means to connect different types of terminal devices to server in order to form the network system.), wherein said terminal device to be used by a user of a system (Col 6, lines 54-56) is recorded in said network server. (Col 2 lines 20-41, User uses the Subscriber Identity Module Card that is connected to the terminal device to identify himself/herself to the Server by entering the password, this process records on the server that the terminal device is being used by the user,) and said network transmits information to said terminal device used by the user (Col 3 lines 48-53.)

Floden has not taught the network server converts information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user.

However, Thomson has taught that it is necessary to convert information (data) format when transferring information from one end to the other end that requires different information format. (Thomason, Col 3 lines 35-41)

A person with ordinary skill in the art would know that not all the devices in a network system receives the same information format, it is required for converting format of the information the suit the destination device.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to have the network server converts information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user as taught by Thomson. Because converting information format is necessary when the information format of the sending device is different than the information format of the receiving device.

10. Referring to Claim 2, Floden in views of Thomson have taught the invention as described in Claim 1. Floden has further taught wherein said network server forms a group of a plurality of terminal devices used by the users, and transmits information sent from a user belonging said group to a terminal device used by another user belonging to said group (see Background of The Invention, Floden has taught the invention works in a cellular communication system. A person with ordinary skill in the cellular phone art would know that there are at least one subscriber (user) for a cellular phone service provider, and all the users that choose the same provide could be considered as a group. And all the cellular phone user knows that they could send messages to each other since sending message another user of the group is a basic function in almost every cellular phone.)

11. Referring to Claim 3, Floden in views of Thomson have taught an invention as described in Claim 2. Floden has further taught the network system further comprising storage means (Col 2 lines 64-67.) and said terminal device includes interface means connected to said storage means storing information peculiar to said user (Col 2, lines 34-41) and for storing specific information on said group to which said user belongs in said storage means connected to said interface means (Col 2, lines 34-41.)
12. Referring to Claim 7, Floden has taught a network server (Fig. 1, element 16) connected to a terminal device (Fig. 1, element 24) via prescribed communication means (Figure 1, element 32, there are various ways of communication means to connect different types of terminal devices to server in order to form the network system.) and recording means for recording said terminal device used by a user (Col 2 lines 20-41, User uses the Subscriber Identity Module Card that is connected to the terminal device to identify himself/herself to the Server by entering the password, this process records on the server that the terminal device is being used by the user;) and transmission means for transmitting information to said terminal device (Col 3 lines 48-53.)

Floden has not taught converting information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user.

However, Thomson has taught that it is necessary to convert information (data) format when transferring information from one end to the other end that requires different information format. (Thomason, Col 3 lines 35-41)

A person with ordinary skill in the art would know that not all the devices in a network system receives the same information format, it is required for converting format of the information the suit the destination device.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to have the network server converts information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user as taught by Thomson. Because converting information format is necessary when the information format of the sending device is different than the information format of the receiving device.

13. Referring to Claim 8, Floden in views of Thomson have taught an invention as described in Claim 7. Floden has further taught said network server further comprising group forming means for forming a group of plurality of users, wherein said transmission means transmits information sent from a user belonging to said group to a terminal device used by another user belonging to said group (see Background of The Invention, Floden has taught the invention works in a cellular communication system. A person with ordinary skill in the cellular phone art would know that there are at least one subscriber (user) for a cellular phone service provider, and all the users that choose the same provide could be considered as a group. And all the cellular phone user knows that they could send messages to each other since sending message another user of the group is a basic function in almost every cellular phone.)



Art Unit: 2155

14. Claims 4-6, 9,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floden et al. US Patent Number 6,230,002 B1, hereinafter Floden, in views of Boyle et al, US Patent Number 56,138,158, hereinafter Boyle.
15. Referring to Claim 4, Floden has taught a network system (Fig. 1, element 10), a terminal device (Fig. 1, element 24) and a network server (Fig. 1, element 16) connected to the said terminal device via prescribed communication means (Figure 1, element 32, there are various ways of communication means to connect different types of terminal devices to server in order to form the network system.), wherein said terminal device to be used by a user of a system (Col 6, lines 54-56) is recorded in said network server. (Col 2 lines 20-41, User uses the Subscriber Identity Module Card that is connected to the terminal device to identify himself/herself to the Server by entering the password, this process records on the server that the terminal device is being used by the user,) and said network transmits information to said terminal device used by the user (Col 3 lines 48-53.)

Floden has not explicitly taught that when there is information to be transmitted to said terminal device used by the user, said network server notifies said terminal device used by the server of the presence of the information to be transmitted.

However, Boyle has taught when there is update of a server content, the mobile would be notified with a message to make users aware that there is information for user to receive so the user can make decision if they want to receive this information or not. (Boyle, Col 5 lines 24-36.)

A person with ordinary skill in the cellular phone art would know that users could send messages to each other in the same group, and the server would first receive

the message from the send user then transmit the message to the requested receiving user.

Applying the teaching of Boyle allows the user be aware of the message that they are going to receive, this would allows the users to make decision if they are going to receive this information or not.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to have the server notifies the user when there is a message going to be sent as taught by Boyle. Because having notification before actually transmitting the data would make user be aware of the information that is going to be transmitted.

16. Referring to Claim 5, Floden in views of Boyle has taught an invention as described in Claim 4. Floden has further taught where the network server forms a group of plurality of terminal devices used by users, and when there is information send from a user belonging to said group, said network server notifies a terminal device used by another user belonging to said group of the presence of the above information. (see Background of The Invention, Floden has taught the invention works in a cellular communication system. A person with ordinary skill in the cellular phone art would know that there are at least one subscriber (user) for a cellular phone service provider, and all the users that choose the same provide could be considered as a group. And all the cellular phone user knows that they could send messages to each other since sending message another user of the group is a basic function in almost every cellular phone. And the notification is already taught by Boyle, as discuss in paragraph 15.)

17. Referring to Claim 6, Floden in views of Boyle has taught an invention as described in Claim 5. Floden has further taught the network system further comprising storage means (Col 2 lines 64-67.) and said terminal device includes interface means connected to said storage means storing information peculiar to said user (Col 2, lines 34-41) and for storing specific information on said group to which said user belongs in said storage means connected to said interface means (Col 2, lines 34-41.)
18. Referring to Claims 9 and 10. Claims 9 and 10 encompass the same scope of the invention as that of the Claims 4 and 5. Therefore, the Claims 9 and 10 are rejected for the same reason as the Claims 4 and 5.
19. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floden.
20. Referring to Claim 11, Floden has taught all the limitation as described in Paragraphs 9, 10 and 11. Claim 11 encompasses the same scope of the invention as that of the Claims 1, 2 and 3. Therefore, the Claim 11 is rejected for the same reason as the Claims 1, 2, and 3.
21. Referring to Claim 12, Floden has taught an invention as described in Claim 11. Floden has further the terminal device wherein the storage means comprises external storage means removable from said terminal device. (Floden, Col 2 lines 64-67, SIM card is well known as a removable storage mean.)

### *Conclusion*


22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims,

Art Unit: 2155

the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

23. Johansson et al., US Patent Number 5,418,837 has taught a method and a apparatus for upgrading cellular mobile telephones by using the Subscriber Identity Module (SIM) Card.
24. Valentine et al., US Patent Number 6,018,654 has taught a network system including a server, terminal devices, connection means and removable storage means.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703) 305-3391. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sheikh Ayaz R can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.
27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Liang-che Alex Wang      *lw*  
November 1, 2002

  
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